

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 17, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claims 8 and 16 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, it is stated that those claims are indefinite because “it is not clear how a flag can be recognized by entering a decryption key”.

In response, Applicant notes that claim 8 does not recite “recognizing a flag by entering a decryption key”. Instead, claim 8 recites “*validating* said flag on the printer” by receiving a decryption key that corresponds to said flag (emphasis added). In view of this fact, Applicant respectfully submits that the purported basis for indefiniteness is not present in claim 8. Accordingly, Applicant respectfully requests that the rejection to claim 8 be withdrawn.

### **II. Claim Rejections - 35 U.S.C. § 103(a)**

Claims 1-5, 7, 8, 10-14, and 16-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui, et al. (“Matsui,” U.S. Pat. No. 6,167,514) in view of Brewer, et al. (“Brewer,” U.S. Pat. No. 6,922,785). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, there at least is no suggestion or motivation in the prior art to modify the references to include those limitations.

In the Office Action, it is, in essence, admitted that Matsui does not teach or suggest any of “adding a header to a file that contains data to be printed”, “providing an identifier in said header that identifies an encryption algorithm”, encrypting the file with the encryption algorithm “without encrypting the header”, or “transmitting said encrypted file

and said unencrypted header to the printer”. Instead, the Office Action merely states that Matsui teaches transmitting an encrypted file from a computer to a printer.

In light of the shortcomings of the Matsui reference, the Office Action relies upon the Brewer reference, which teaches decrypting received *communication packets* using a decryption algorithm identified by a flag contained in the *packet* headers. Not described in the Brewer reference, however, is providing an identifier in the header of a “file that contains data to be printed”, the identifier identifying an encryption algorithm that was used to encrypt the file. Moreover, not described in the Brewer reference is identifying an identifier and decrypting a file *on a printer*.

Although the Office Action argues that a printer “must know what algorithm is used in the encryption process in order to decrypt the received data,” there are many alternative methods in the prior art for “knowing” what that algorithm is. In other words, there is no reason why the encryption algorithm used to encrypt a file must be identified in the file header. In fact, Matsui explicitly describes a system in which no such identification is made to the printer. In Matsui’s system, a PC transmits its identification information to a printer and receives identification information from the printer. A cryptographic key is then generated by the PC using the printer identification information, and the file to be printed is encrypted by the PC using that generated cryptographic key. The encrypted file is received by the printer and then decrypted using a cryptographic key generated by the printer using the PC identification information. See Matsui, column 8, line 38 to column 9, line 20. Therefore, Matsui already contemplates one such alternative method for “knowing” what decryption algorithm to use.

Regardless of the above, there is no support in the prior art for incorporating Brewer's packet handling method in Matsui's print system. Specifically, there is no suggestion or motivation in the prior art to (i) include Brewer's flags in *file* headers (as opposed to communication packet headers), or (ii) perform the flag identification and decryption performed in the Brewer system *on a printer*. Given the lack of a suggestion or motivation of the prior art, it appears that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. See *Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

In addition to the lack of suggestion or motivation to add aspects of Brewer's packet handling method to the Matsui system, there further is no suggestion or motivation to dispose of Matsui's current encryption process described in the foregoing in favor of Brewer's method. Specifically, there is no suggestion or motivation to discard Matsui's encryption/decryption process, which is the focus of Matsui's entire disclosure. Indeed, the emphasis Matsui places on his encryption/decryption process would *teach away* from the modification suggested in the Office Action. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the

applicant . . .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

In view of the foregoing, it is respectfully submitted that Applicant’s claims are patentable over Matsui/Brewer and that the rejection of these claims should be withdrawn.

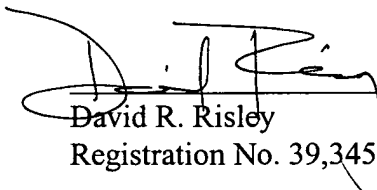
### **III. Canceled Claims**

Claims 6, 9, 11-16, 18, 25, and 26 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

1-26-06

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Signature